



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/672,829 | 09/29/2000 | Cathal McGloin | P65973US0 | 2975 |
| 136 | 7590 | 07/28/2004 | EXAMINER | |
| JACOBSON HOLMAN PLLC 400 SEVENTH STREET N.W. SUITE 600 WASHINGTON, DC 20004 | | | BUI, KIM T | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3626 | |

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/672,829

Applicant(s)

MCGLOIN ET AL.

Examiner

Kim T. Bui

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/05/04 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-7, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ibarra (6119097) in view of Powers et al. (6615182) and further in view of Darlings (Darling et al., "Databases with character," InfoWorld, February 21, 1994, vol. 16, issue 8, pages 67-79).

(A) As per claim 1, Ibarra teaches a performance management system for use in an organization having employees working to achieve organization performance goals, the system comprising:

a. a configuration functions comprising:

an employee set up function including means for creating a database record for an employee (Ibarra, col. 6, lines 11-14, col. 10, lines 41-49);

an objective function including means for configuring objectives for employee performance ; the objectives include target period (.e. monthly) for which performance measurement data is compared with a threshold level (i.e. standards referred by number/score) (Ibarra, col. 2, lines 48-64, lines 66-67, col. 5, lines 10-12, col. 6, lines 40-42, lines 54-56).

b. an information management function including means for processing said stored performance measurement data according to objective to generate employee performance data (Ibarra, col. 2, line 66 to col. 3, line 7);

c. a database including means for storing said employee performance data and for interfacing with the configuration and the information management functions (Ibarra, col. 4, lines 48-65)

Ibarra fails to expressly teach integration engine for automatically capturing from an external system performance measurement data concerning performance of employees and a database connected to the engine for storing received performance data. However, this feature is old and well known in the art, as evidenced by the Powers et al. with regards to a data importer 48 for importing productivity data from external sources such as telephonic switches and database space 16 for mapping and storing data (i.e, configuration, procedures, productivity). (Powers et al., col. 4, line 54 to col. 5, line 45). It is respectfully submitted, that it would have been obvious to one having ordinary skill in the art at the time the invention were made, to expand the system

teaches by Ibarra with Powers et al. teachings with the motivations of providing flexibility of the system's configuration suitable for remote data (Powers et al, col. 4, line 67 to col. 5, line 2). Regarding the objective group function for configuring group of objectives and weighting for each objective, both Ibarra and Powers et al teach group of objectives and weighting factor assigned to each objective (Ibarra, col. 9, lines 1-15; Powers et al, col. 13, lines 1-35).

The combined system of Ibarra and Powers et al fails to teach the data dictionary means for creating data dictionary items defining how performance measurement data imported into the system is processed and displayed, said data dictionary function including menu means for creating database field, defining formulas by which data field is calculated, and establishing rules to determine how a result obtained for a database field is entered, displayed and calculated. However, this feature is old and well known in the art, as evidenced by Darlings' teachings with regards to data dictionary means for creating a database field defining how performance measurement data imported into the system is processed and displayed, said data dictionary function including menu means for creating database field, defining formulas by which data field is calculated, and establishing rules to determine how a result obtained for a database field is entered, displayed and calculated. (Darlings, page 2, paragraph 9, page 6, paragraph 11, page 7, paragraph 1, page 9, paragraph 5, page 11, paragraphs 7,8, page 15, paragraphs 5-7 ; page 17, paragraphs 4-5). Additionally, with respect to the newly added features of the menu including data entry options to describe data field, to specify organization hierarchical level for a field, to set data measurement period, defining

formula for calculating variable fields, to specify display mask, manual data entry and overrides. The capability to establish rules for data entry, to assign format and data types, to edit masks and calculate fields using data dictionary is disclosed by Darlings. The objectives for providing data fields for identifying members, date and value of data elements, for measuring performance during specified time interval, for specifying organization hierarchical levels, for calculating at least two variable (i.e. quality and productivity scores) using weighting functions and mathematical operation, for overriding performance measurement criteria, standard, activities etc.. are disclosed in Ibarra and Powers et al. See for example, Ibarra, col. 4, lines 15-30, col. 9, lines 15-21, col. 10, lines 10-15, col. 3, lines 38-41, col.9, lines 3-20, Powers et al. , the abstract, col.1, line 60 to col. 2, line 33, col. 6, lines 20-31, Fig. 3, col. 10, lines 12-34, col. 11, line 10- to col. 12, line 65, col. 13, line 66 to col. 14, line 25. It is respectfully submitted, that it would have been obvious to one having ordinary skill in the art at the time of the invention to implement the objectives readily available in the collective system of Ibarra and Powers et al using data dictionary of Darlings with the motivation of providing enhanced database definition and administration functions (Darlings, page 2, paragraphs 9).

(B) As per claim 2, Ibarra and Powers et al teaches the objective group function for associating employee with objectives in the group, and weighting factor (Ibarra, col. 9, lines 1-15; Powers et al, col. 13, lines 1-35).

(C) As per claim 3, Powers et al. teaches means for associating a user and member ID for evaluation and calculating of quality and productivity scores (i.e. appraisal rating

Art Unit: 3626

group) for each performance area with reference to the target value (i.e. performance expectation), and summation of all performance areas for an overall rating. Powers et al. col. 11, line 10 to col. 13, line 42.

(D) As per claim 4, Ibarra teaches the configuration functions comprises an objective wizard function for configuring objectives for employee and team performance (Ibarra, col. 2, lines 48-64, col. 4, lines 30-39, col. 10, lines 3-40)

(E) As per claim 5, Ibarra teaches means for prompting input of objective description and appraisal definitions (Ibarra, col. 2, lines 45-65 and col. 5, lines 4-12), Powers et al. teaches means for prompting input (i.e. edit box, radio buttons, horizontal scroll etc..) and for selecting configuration for importing productivity data for a rating calculation (Powers et al. col. 9, lines 52-61, col. 11, lines 48-63, col. 12, line 11 to col. 13, line 42).

(F) As per claim 6, Ibarra teaches KPI wizard function for prompting user input of organization level ratings (i.e. minimum, expected, outstanding) and thresholds. Ibarra, Fig. 3, col. 6, lines 40-60.

(G) As per claim 7, Ibarra teaches a KPI group configuration function for grouping KPIs together for reporting purposes, and the information management functions comprise a KPI group review function for outputting group review data (Ibarra, col. 9, line 25 to col. 10, line 2).

(H) As per claim 15, the claim repeats the features of claims 1-3 and is therefore rejected for the same reasons given above in the rejections of claims 1-3 and incorporated herein.

4. Claims 8-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ibarra (6119097), Powers et al. (6615182) , and Darlings (Darlings et al. , "Databases with character", InfoWorld, February 21,1994, vol. 16, issue 8, pages 67-69) as applied to claim 1 above and further in view of Official Notice.

(A) As per claims 8-14, the combined system of Ibarra, Powers et al. and Darlings collectively fail to expressly teach three-tier software architecture using object-oriented programming and proxy stub pairs which are used for remote procedure calls. However, Ibarra clearly teaches that the system is designed using software and can be used over a computer network (Ibarra, col. 5, lines 58-62 and col. 10, line 66 to col. 11, line 3). The examiner takes Official Notice that the use of a three-tier software architecture using object-oriented programming and proxy stub pairs in a system written by software and supporting network communications is well-known computer arts (See Microsoft computer dictionary 5th edition, pages 276,373,449 and 519, attached at the end of the previous Office Action mailed 02/13/03). Thus, it is respectfully submitted, that it would have been obvious to one having ordinary skill in the art at the time the invention was made, perform the functions of Ibarra, Powers et al. and Darlings using three-tier software architecture using object-oriented programming and proxy stub pairs, with the motivation of increasing the flexibility of the software system.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent

and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6,11-17 of copending Application No. 09-672830. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claims 1-6,11-17 of Application No. 09-672830 recites a performance management system using data dictionary function in a call center configuration.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

7. Applicant's arguments with respected to the amended claims have been considered but are moots in view of new ground(s) of rejection.

(A) On pages 8-11 of the 08/08/03 communication, Applicant argues that Ibarra fails to teach data automatically imported from an external system that may be configured and manipulated according to data dictionary and Darlings fails to teach the specific data functions. In response, Powers et al and Darlings clearly teach the data dictionary and the data automatically imported from an external system and dictionary as discussed in the above rejection, and even though Darlings does not expressly disclose the recited functions, the reference teach the capability of data dictionary for implementing these functions suggested by Powers et al. and Ibarra. See the above rejection. Further, the Examiner respectfully submitted one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merch & Co.*, 800 F. 2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In addition, it is respectfully submitted that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

(B) Applicant's arguments regarding Powers' 795 and Havens are moots in view of new ground(s) of rejection.

Conclusion


8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. "Logical Expression Calculation Interface" (5428738), " System For Monitoring and Controlling The Performance Of A Call Processing Center" (5500795), " Knowledge Worker Productivity Assessment" (5909669); " Graphical User Interface For Creating Database Integration Specifications" (5721912).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim T. Bui whose telephone number is 703-305-5874. The examiner can normally be reached on Monday-Friday from 8:30A.M. to 5:00P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


KTB
07/22/04.


ALEXANDER KALINOWSKI
PRIMARY EXAMINER